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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,132	05/23/2000	Kia Silverbrook	NPA005US	9161

24011 7590 09/25/2003

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

LE, KHANH H

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/575,132

Applicant(s)

SILVERBROOK ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### **Detailed Action**

1. This Office Action is in response to the original application. Claims 1- 28 are now pending. Claims 1, 14 are independent.

### **Examiner's Note**

2. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all references passages as potentially teaching all or part of the claimed inventions.

### **Objections**

3. Claim 10 is objected to as being unclear. It seems that "the information" should be "the document" to be consistent with the parallel system claim 24. Clarification or appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Intelligent Paper" by M. Dymetman, and Max Copperman, in Electronic Publishing, Artistic Imaging and Digital Typography, Proceedings of EP '98, March/April 1998, Springer Verlag LNCS 1375, pp 392-406.

As to claim 1, "Intelligent Paper" discloses Interactive paper, a method for providing content in a document, including:

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the document having at least one user interactive element which enables the user to indicate a request for further information relating to the content by interacting with the element using a sensing device which is adapted to transmit data indicating the request to a computer system. (see at least pages 1-2) .

Further providing targeted content in a document, including:  
providing a user with a printed document, formatted to include information with content targeted to demographics of the user, which enables the user to indicate a request for further information relating to the content and allowing to transmit data indicating the request to a computer system is well-known.

It would have been obvious to one skilled in the art at the time of the invention to add such known targeted marketing method to Intelligent Papers teachings to take advantage of the benefits of the interactive Technology such as "complimentarity" as explained in Intelligent Papers, page 1, first paragraph.

As to Claim 2, "Intelligent Paper" discloses sending information after request from a user over a computing system (see at least p.1-2) .

As to Claims 3, 4 ,5  
wherein the document is formatted according to user preferences.  
wherein the targeted content comprises advertising material.  
wherein the at least one interactive element is provided in association with the advertising material and the further information is provided in the form of a printed product brochure

The above marketing methods are well-known and it would have been obvious to one skilled in the art at the time of the invention to incorporate those well-known marketing methods into the teachings of "Intelligent Paper" to effect the advertising goals.

As to claims 6-12: "Intelligent Paper" discloses  
Claim 6. the document includes coded data indicative of an identity of the document and of the at least one interactive element,  
and wherein the method includes  
receiving, in the computer system, indicating data from the sensing device regarding the identity of the document and a position of the sensing device relative to the document in order to identify the document and determine when the sensing device is used to interact with the element.

Claim 7.(dependent on claim 6), including receiving, in the computer system, **movement data** regarding movement of the sensing device relative to the document.

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Claim 8.(dependent on claim 7), including the sensing device sensing its movement relative to the document using at least some of the coded data, and identifying the request in the computer system from the movement being at least partially within a zone associated with the interactive element.

Claim 9.Providing the sensing device with an identification code specific to a particular user and the method including monitoring use of the sensing device in the computer system ("Intelligent Paper", page 401, product catalogues)

Claims 10-12 (see, "Intelligent Paper", pages 1-2 at least).

A method as claimed in claim 6, including printing the information on a surface (interpreted as a paper) of a surface-defining structure (interpreted as a printer), and at the same time, printing the coded data on the surface.

Claim 11.(dependent on claim 6), which includes printing the coded data to be substantially invisible in the visible spectrum.

Claim 12, retaining a retrievable record of the printed document, the document being retrievable using the identity data as contained in the coded data.

As to claim 13.binding pages if the document is printed on multiple pages is known and it would have been obvious to one skilled in the art at the time of the invention to add such binding if the document is more than one page. (see e.g. "Intelligent Paper", page 401, product catalogues)

Claims 14, 15, 16, 19, 20 , 21, 22 substantially parallel the limitations of claims 1, 4,3, 6 ,7, 8 and 9, respectively, in system format and are rejected on the same basis.

As to claims 17-18, using an advertising server for providing the advertising material to the publication server and using a registration server where demographic data of the user is stored for access by the publication server, in order to" allow the advertising material to be demographically targeted are well-known marketing methods; thus it would have been obvious to one skilled in the art at the time of the invention to add those well-known methods in the teachings of to effect targeted marketing.

Claim 23. (dependent on claim 14)

"Intelligent Paper" discloses the sensing device includes a marking nib. (see, "Intelligent Paper",Fig. 1 at least).

Claims 24-26 substantially parallel the limitations of claims 10-11 respectively, in system format and are rejected on the same basis.

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Claims 27-28 substantially parallel the limitations of claims 12-13 respectively, in system format and are rejected on the same basis.

### Conclusion

6. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

<http://www.lri.fr/~mackay/pdffiles/IWAR99.InteractivePaper.pdf> "Designing Interactive Paper: Lessons from three Augmented Reality Projects" by Wendy E. MacKay and Anne-Laure Fayard

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113

*KHL*

September 5, 2003

KHL

*Steve Gravini for R/S*

STEPHEN GRAVINI  
PRIMARY EXAMINER